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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Thomas F. Doyle

Application No.: 09/866,865 Group: 2161

Filed: May 29, 2001 Examiner: Not Yet Assigned

For: Automated Exchange for Determining Availability of Assets Shareable Among Entities

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231

on 10/30/01 Eileen M. Woodbury
Date Signature

EILEEN M. WOODBURY
Typed or printed name of person signing certificate

PETITION UNDER 37 C.F.R. §1.47(b);
TRANSMITTAL OF DECLARATION/POWER OF ATTORNEY

RECEIVED

JAN 15 2002

OFFICE OF PETITIONS

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Terion, Inc. petition that the above-captioned application be accepted under 37 C.F.R. §1.47(b). The petition fee required under 37 C.F.R. §1.17(h) is provided herewith. The enclosed Declaration of Jong P. Hong, Legal Memorandum Establishing Proprietary Interest, and Statement Establishing Proprietary Interest are filed in support of this Petition.

The sole inventor, Thomas F. Doyle, has refused to cooperate in signing a Declaration for the above-referenced application.

The last known address of Thomas F. Doyle is:

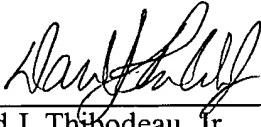
13819 Royal Melbourne Sq.
San Diego, CA 92128-3643

The Declaration/Power of Attorney document has been executed by Kenneth J. Cranston, President of Terion, Inc., on behalf of the inventor in the application and is being submitted herewith in response to the Notice to File Missing Parts of application dated July 30, 2001. The enclosed Addendum to Declaration is filed in support of this Declaration.

Please charge any additional fees due in this matter to Applicants' attorney's Deposit Account No. 08-0380. A copy of this letter is enclosed for accounting purposes.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By 
David J. Thibodeau, Jr.
Registration No.: 31,671
Tel.: (978)341-0036
Fax: (978) 341-0136

Concord, MA 01742-9133

Date: 10/30/01

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on <u>10/30/01</u>	Date	<u>Eileen M. Woodbury</u>
<u>Eileen M. Woodbury</u>		
Typed or printed name of person signing certificate		

DECLARATION OF JONG P. HONG.

Assistant Commissioner for Patents
Washington, D.C. 20231

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OFFICE OF PETITIONS

Sir:

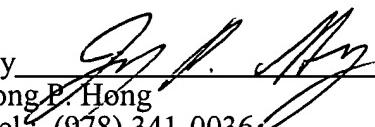
1. I, Jong P. Hong, hereby declare as follows:
2. I am an attorney employed by Hamilton, Brook, Smith & Reynolds, P.C.
3. I am submitting the present Declaration in support of a petition under 37 C.F.R. 1.47(b) being filed herewith to establish that the sole inventor of the present application, Thomas F. Doyle, has refused to sign a Declaration/Power of Attorney in connection with the present invention.
4. As of at least April 1, 2001, Thomas F. Doyle was employed by Terion Inc. ("Terion") as Vice-President of Marketing.

5. A dispute has arisen between Terion and Mr. Doyle relating to a number of matters regarding his employment agreement with Terion.
6. On June 6, 2001, a letter, a copy of the present application, and a Declaration/Power of Attorney document were sent to Linda Ward, Office Manager at Terion, for execution by Mr. Doyle. A copy of the letter is attached as Exhibit A.
7. On August 6, 2001, I received a telephone call from Ms. Ward. Ms. Ward stated that she was unable to obtain Mr. Doyles signature because he was no longer employed at Terion. Ms. Ward also stated that the letter and copy of present application were forwarded to Mr. Doyle. However, she did not receive any response from Mr. Doyle.
8. On August 8, 2001, a letter and a Declaration/Power of Attorney were sent by Certified Mail to Mr. Doyle at his last known home address requesting his participation in this patent application. A copy of the letter and certified mail receipt is attached hereto as Exhibit B. No response to that letter has been received.
9. On September 12, 2001, I spoke by telephone with Mr. Doyle. He stated that he had received the letters of June 6, 2001 and August 8, 2001 including a copy of the Declaration/Power of Attorney and a copy of present application from Ms. Ward. However, he explained that he had lost the copy of present application and thus, was not able to review the application and sign the Declaration.
10. On September 13, 2001 a letter, a copy of the present application, and another Declaration/Power of Attorney document were sent to Mr. Doyle. A copy of the letter is attached as Exhibit C.

11. On September 21, 2001, Mr. Doyle called me to acknowledge the receipt of the letter of September 13, 2001 including a copy of the present application and a Declaration/Power of Attorney. Mr. Doyle explained that he understood his duty to assign his rights to Terion and sign the Declaration. However, he also stated that he will not review the present patent application nor sign the Declaration and Assignment until the dispute between Mr. Doyle and Terion regarding his duties and obligations are resolved.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By 
Jong P. Hong
Tel: (978) 341-0036
Fax: (978) 341-0136

Concord, MA 01742-9133

Date:

10/30/01



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Thomas F. Doyle

Application No.: 09/866,865 Group: 2161

Filed: May 29, 2001 Examiner: Not Yet Assigned

For: Automated Exchange for Determining Availability of Assets Shareable Among Entities

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LEGAL MEMORANDUM
ESTABLISHING PROPRIETARY INTEREST

Under Florida law, in the absence of an express assignment, an employer may claim an employee's inventive work where the employment relationship infers an "implied-in-fact contract" to assign patent rights. Teets v. Chromalloy Gas Turbine Corp., 83 F.3d 403, 407 (Fed. Cir. 1996). In particular, when the employee is specifically hired or directed to exercise inventive faculties, the employee has received full compensation for his or her inventive work. Id. at 407. Even if hired for a general purpose, an employee with the specific task of developing a device or process may cede ownership of the invention from that task to the employer. Id. at 408.

A court would award title of the invention to Terion, Inc. ("Terion") because the employment relationship between Terion and Mr. Thomas F. Doyle infers an implied-in-fact

contract to assign patent rights. Terion is a Delaware corporation, having a place of business in Melbourne, Florida. Although employed by Terion as Vice-President of Marketing, Mr. Doyle's duties included development of new products as well as seeking and obtaining patents. Mr. Doyle conceived the subject matter of the above-referenced application while employed by Terion. A prior provisional application was filed with U.S Patent and Trademark Office on April 27, 2000. Mr. Doyle used Terion's resources to reduce the invention to practice. In addition, Terion paid for prosecution of Mr. Doyle's patent applications, including the prior provisional application. Therefore, applying the cited case law, Mr. Doyle's employment relationship with Terion inferred an implied-in fact contract to assign patent rights in this invention to Terion.

Under Florida law, an officer or director of a corporation occupies a quasi-fiduciary relation to the corporation, and is bound to act with fidelity and the utmost good faith. Flight Equipment & Engineering Corp. v. Shelton, 103 So.2d 615 (Fla. 1958). In accepting the office he impliedly agrees and undertakes to give the corporate enterprise the benefit of his best care and judgment and to exercise his powers in the interest of the corporation. In addition, a corporate officer or director may not take a business opportunity for his own if the corporation is financially able to exploit the opportunity, the opportunity is within the corporation's line of business, the corporation has an interest or expectancy in the opportunity, and by taking the opportunity for his own, the corporate fiduciary will thereby be placed in a position inimicable to his duties to the corporation.

Since Mr. Doyle held an office during his employment at Terion as Vice-President of Marketing, he was in a fiduciary relationship with Terion. Mr. Doyle's fiduciary duties to Terion require that he does not exploit his patent rights in inventions made during his employment and relating to Terion's business. In addition, in view of Mr. Doyle's fiduciary duties to Terion, a court would find that the employment relationship between Terion and Mr. Doyle inferred an implied-in-fact contract to assign his patent rights and award title of the invention to Terion.

Thus, the 37 CFR 1.47 (b) application, Terion, Inc., has a proprietary interest obtained by an implied-in-fact contract to assign patent rights.

The facts in support of this Legal Memorandum are in the accompanying Statement Establishing Proprietary Interest document. A copy of the cited cases are attached as Exhibits D and E.

TERION, INC.

By its attorney,

By David J. Thibodeau
David J. Thibodeau, Jr. (Florida Bar Member No. 45,799)
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
PO Box 9133
Concord, MA 01742-9133

Dated: 10/30/01

::ODMA\HODMA\Manage;264295;1
WP 9.0
DJT/JPH/emw
10/17/01



PATENT APPLICATION
Docket No.: 2293.2008-000

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on <u>10/30/01</u>	<u>Eileen M. Woabury</u>
Date	Signature
<u>Eileen M. Woabury</u>	
Typed or printed name of person signing certificate	

STATEMENT ESTABLISHING PROPRIETARY INTEREST

I, Kenneth J. Cranston, hereby declares as follows:

I am the person signing the Declaration for Patent Application in the above-identified application on behalf of the non-signing inventor. I make this Declaration as to the facts establishing a proprietary interest in this application.

To the best of my knowledge and belief, as of the date I signed the Declaration for Patent Application, the proprietary interest in this invention belonged to:

Terion, Inc.
420 N. Wickham Road
Melbourne, FL 32935.

As President of Terion, Inc. ("Terion") I am authorized to sign this statement on behalf of that corporation.

The assignee, Terion, Inc., states that to the best of its knowledge and belief title is in the assignee seeking to take this action.

Specifically, the sole inventor, Thomas F. Doyle was employed by Terion, Inc. from November 1998 to at least April 2001. During the employment at Terion, Inc., Mr. Doyle held

an office of fiduciary duty and trust as Vice-President of Marketing. By virtue of Mr. Doyle's employment and fiduciary duty owed to Terion, Inc. as a corporate officer, Mr. Doyle has agreed to transfer all patent rights related to or necessary for Terion's business to Terion, Inc.

The invention of the above-referenced patent application entitled "Automated Exchange for Determining Availability of Assets Shareable Among Entities" was made by Mr. Doyle while employed by Terion, Inc. Thus, all rights to the above-referenced patent application were retained by Terion, Inc.

It is also believed that such action is needed to prevent irreparable damage and to preserve the rights of Terion, Inc. in this invention.

Therefore, the filing date must be maintained in the above-referenced application to preserve patentability of this invention.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with a knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code, and that such willful, false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this Declaration is directed.

Respectfully submitted,

By Kenneth J. Cranston
Kenneth J. Cranston

Dated: